

Patent  
Attorney Docket: AUS920010178US1  
(IBM/0005)

### REMARKS

Applicant thanks the Examiner for taking the time to discuss issues addressed in this response to the office action during a telephone interview. This response documents the issues discussed during the interview.

Claims 1, 3-10, 12, 13, 15-21, 28 and 31-37 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant has amended independent claims 1, 12 and 28 from "database" to "database on a server" to bring these claims within the technological arts. Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 12 and 28 as well as the claims that depend therefrom, either directly or indirectly.

Claims 1, 2, 7, 8, 11, 12, 13, 18, 19, 22, 23, 28, 29, 34, 35, 38 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,905,246 of Fajkowski. Fajkowski provides a system for the electronic management and redemption of coupons. (Fajkowski, Abstract). The system includes a coupon card for holding scanned coupons and a server computer that collects redeemed coupon information from the coupon card and provides information such as redemption requirement data. *Id.* Fajkowski discloses that coupons may be scanned onto the card and that the card can be scanned to identify and overwrite any expired coupons, thereby removing the expired coupons from the card. (Fajkowski, col. 16, line 60 – col. 17, line 21).

Fajkowski further discloses that a cashier may, as a customer service gesture, redeem a coupon that is expired or offer a rain check if the coupon is close to being expired and the product is sold out. (Fajkowski, col. 19, line 50 – col. 20, line 10). The cashier does this by entering an override code so that the coupon may be processed as directed by the cashier. *Id.*

Fajkowski also discloses a rainchecking feature that allows a store to rewrite the coupon to provide a raincheck when the coupon is close to being expired. (Fajkowski, col. 20, line 34 – col. 21, line 6). Fajkowski then discloses that at a later date, the customer may inform the store that she has a raincheck and that the cashier can then press a "rainck" key. Pressing the key generates a list of expired coupons or coupons that have been rewritten to include a raincheck. Checking

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this list for the desired raincheck, the cashier can push the "Accept" key to accept the raincheck coupon. *Id.*

Applicant claims a computer implemented method, server, system and medium comprising, *inter alia*, maintaining an e-coupon database on a server that comprises an e-coupon identifier, an e-coupon expiration condition, and a post-expiration instruction, receiving a request to redeem an expired e-coupon and then executing the post-expiration instruction associated with the e-coupon identifier.

The MPEP § 2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Furthermore, the Federal Circuit held in *Paperless Accounting, Inc. v. Bay Area Rapid Transit Systems*, 804 F.2d 659 (Fed. Cir. 1986): "[A] §102(b) reference must sufficiently describe the claimed invention to have placed the public in possession of it." *Id.* at 665.

Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented because the cited reference fails to describe each and every element as set forth in independent claims 1, 12, 23 and 28. First, Fajkowski fails to disclose a database on a server that includes an e-coupon identifier, an e-coupon expiration condition and a post-expiration instruction. Fajkowski discloses a clearinghouse database on a server but fails to disclose that the clearinghouse database maintains post-expiration instructions. The clearinghouse database is disclosed as receiving information on redeemed coupons from the servers of the retailers participating in the system. (Fajkowski, col. 5, lines 14-16). This disclosed database on the server has many uses, but Fajkowski does not disclose that the database includes a post-expiration instruction.

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Secondly, Fajkowski fails to describe executing the post-expiration instruction associated with the e-coupon, another element claimed by Applicant. The post-expiration instruction claimed by Applicant is maintained in the database on the server and then executed. Fajkowski discloses that the customer must remind the store that a raincheck has issued and then the clerk must press a "rainchk" button to retrieve a list of expired coupons, must then identify the one having a raincheck and must then press the "Accept" key to redeem the coupon. The disclosure by Fajkowski does not disclose *executing* the post-expiration instruction *stored in the server database*. Furthermore, since Fajkowski fails to disclose a database on a server having a post-expiration instruction, Fajkowski cannot disclose executing the post-expiration instruction. Again, Fajkowski does not disclose the identical invention of Applicant in as complete detail as is contained in the claim as required for a *prima facie* case of anticipation.

Therefore, because the cited prior art does not disclose each element of the claimed invention, Applicant respectfully asserts that a *prima facie* case of anticipation is lacking. Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 12, 23, and 28 and those dependent claims that depend therefrom, either directly or indirectly.

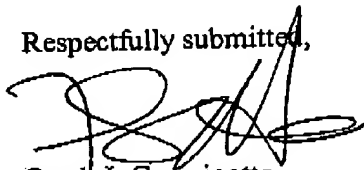
Claims 3, 4-6, 9, 10, 14, 15-17, 20, 21, 24-27, 30, 31-33, 36, 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,905,246 of Fajkowski. For the reasons provided in the remarks above concerning independent claims 1, 12, 23 and 28, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 3, 4-6, 9, 10, 14, 15-17, 20, 21, 24-27, 30, 31-33, 36 and 37, which depend either directly or indirectly from independent claims 1, 12, 23 and 28.

Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests the timely issuance of a Notice of Allowance. If the Examiner believes that a telephone interview with the undersigned attorney would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the convenience of the Examiner. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No.

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50-0714/IBM/0005 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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